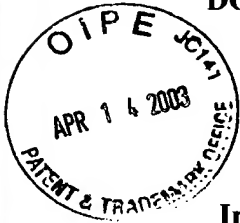


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DOCKET NO.: ISIS-4803

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Cook Et Al.

Serial No.: 09/973,981

Filing Date: October 9, 2001

For: NUCLEOSIDIC AND NON-NUCLEOSIDIC FOLATE CONJUGATES

Confirmation No.: 9800

Group Art Unit: 1637

Examiner: Jezia Riley

EXPRESS MAIL LABEL NO: EV 252264326 US
DATE OF DEPOSIT: April 14, 2003

Assistant Commissioner for Patents
Washington DC 20231

REPLY PURSUANT TO 37 CFR § 1.111

This is in response to the Restriction Requirement dated March 20, 2003, issued in connection with the above-identified application. The Office Action requires restriction to one of five claimed inventions, parsed into the following groups:

- Group I:** Claims 1-6, 13-20 and 94-100, drawn to compounds, classified in class 514, subclass 279; class 544, subclass 224;
- Group II:** Claims 8-12, 32, 33, 35, 40, 42, 63-68, 72, 79-81, 88-90, 93 and 101-109, drawn to compounds, classified in class 536, subclass 22.1;
- Group III:** Claims 43-44, drawn to methods for making folic acid derivatives, classified in class 514, subclass 279; class 544, subclasses 1, 224;
- Group IV:** Claim 91, drawn to a folate conjugate, classified in class 514, subclass 279; class 544, subclass 224;
- Group V:** Claim 92, drawn to an oligonucleotide-folate conjugate, classified in class 536, subclasses 22.1, 25.3, 25.32, 27.1.

In response, Applicants elect Group II (*i.e.*, claims 8-12, 32, 33, 35, 40, 42, 63-68, 72, 79-81, 88-90, 93 and 101-109). However, this election is made with traverse.

In order for a restriction to be proper, the Examiner must demonstrate that the inventions are independent or distinct as claimed; **and** that there is a serious burden on the examiner. *See* MPEP § 803.01. The only basis for entry of the restriction set forth in the Office Action is that the invention of Group I does not require the invention of Group II-V and that the invention of Group II does not require the inventions of Groups I, III-V (*see* Office Action at 2).

The Office Action does not set forth any basis for alleging the inventions are independent (*i.e.*, there is “no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect”) and that they are “distinct” (*i.e.*, “two or more subjects are disclosed as related, . . . but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER). *See* MPEP § 802.01 (emphasis original). Moreover, the Examiner has failed to demonstrate any undue burden of conducting a search that would include claims of Group II and Group V, which fall within the **same** class and subclass (*i.e.*, Class 536 and Subclass 22.1) (or Group I and Group III, which are in Class 514, Subclass 279 and Class 544, Subclass 224). Accordingly, the Office Action fails to set forth reasons sufficient to support the Examiner’s proposed parsing of Applicants’ claims.

Applicants respectfully submit that the foregoing constitutes a *bona fide* attempt to advance prosecution. Applicants solicit an early Office Action on the merits.

Date: April 14, 2003



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